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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/461,265 12/15/99 MASON

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QM12/0806

EXAMINER

GOODMAN, C

ART UNIT

PAPER NUMBER

3724

DATE MAILED:

08/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/461,265

Applicant(s)

MASON, NEIL

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 12 and 17-19 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. The Amendment filed on May 16, 2001 has been entered.

***Specification***

2. The disclosure is objected to because of the following informalities:
  - i. The specification lacks proper headings. Note comments in the last Office Action.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 8, 10, 11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Vannuvel (BE 440,688).

Vannuvel discloses a saw blade clamping arrangement comprising all the elements claimed including, *inter alia*, a reciprocable shaft 1; a retaining member 7, 8 being lockable in at least two positions; and a restraining means 2. See whole patent.

5. Claims 1-8, 10, 11 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang.

Huang discloses a saw blade securing mechanism comprising all the elements claimed including, *inter alia*, a reciprocable shaft 20; a retaining member 52, 53 being lockable in at least two positions; restraining means 40, 201, 202; and recess 21. See whole patent.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vannuvel (BE 440,688).

Vannuvel discloses the invention substantially as claimed except that it does not appear that Vannuvel includes a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Vannuvel with a plurality of arms to facilitate additional positioning means for saw blades of various lengths, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Huang discloses the invention substantially as claimed except for a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Huang with a plurality of arms to facilitate reinforced mounting of the saw blade, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palm in view of Huang.

Palm discloses the invention substantially as claimed except for the specifics of the blade mount. However, Huang teaches a blade mount comprising a first wall 201 having a recess 21 formed therein; a biased pin 52, 53 disposed through said first wall and having a lug 523 received in said recess; said pin movable against said bias to move said lug out of said recess, said pin secured against rotation while said lug is received in said recess, and said pin rotatable when said lug is moved out of said recess for the purpose of providing a holder for easy replacement of the saw blade as well as for adjustment to different angular positions. See Figs. 1-6, c. 1, ll. 22-28. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Palm with the blade mount as taught by Huang in order to facilitate easy replacement and angular adjustment of the saw blade.

### ***Allowable Subject Matter***

10. Claims 12 and 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

11. Applicant's arguments filed May 16, 2001 have been fully considered but they are not persuasive.

In response to Applicant's basic argument that the references do not anticipate the claimed invention,<sup>1</sup> this argument lacks merit. First, it is irrelevant whether the references are manual saws since nothing in the claims requires that distinction. Moreover, it is also irrelevant whether the references have shafts that would be mounted in a reciprocating saw because as Applicant correctly notes, it is disclosed but NOT claimed. Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Second, Applicant's allegation that the references are improper prior art because they are somehow non-analogous is not well taken. Manual saws are the genus from which the species of reciprocating saws are derived. For this reason alone, Applicant's assertions fail. Third, the handles of the references for which the Examiner referred to as reading on the claimed reciprocable shaft are properly identified as such based upon a reasonably broad interpretation of the same. The difference is only the breadth of terminology used to claim the same feature since contrary to Applicant's assertions, the handles in the references perform the same reciprocating function as the claimed shaft and since even the claimed shaft would be construed as a "handle", i.e. it is a part holding the saw blade and it can be manipulated by hand.

In response to Applicant's argument that there is no suggestion to combine the references,<sup>2</sup> the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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<sup>1</sup> Amendment B, Paper No. 10, p. 3, l. 7 - p. 4, l. 10.

<sup>2</sup> Id., p. 4, l. 11 - p. 5, l. 10.

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine stem from both references. First, as noted above, both Palm and Huang are clearly analogous to each other, the former being the species and the latter being the genus, and this is clearly evident to one skilled or of ordinary skill in the art. Second, Palm inherently includes a blade mount but lacks any details thereof. On the other hand, Huang clearly teaches a blade mount comprising the claimed elements to facilitate clamping of a saw blade. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide Palm with the specific clamping means as taught by Huang for the reasons stated in the rejection *supra*.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning,<sup>3</sup> it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Conclusion***

12. Grant et al, Parrish et al, and Jungmann et al are cited as additional pertinent art.
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

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<sup>3</sup> Id.




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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg   
July 31, 2001

**Charles Goodman**  
**Patent Examiner**  
**AU 3724**

  
**Rinaldi I. Rada**  
**Supervisory Patent Examiner**  
**Group 3700**